

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

Ex parte PHILLIP M. BRAUN, WILLIAM A. BREDALL,  
MICHAEL ROBERTS, THOMAS CRAIG MASTERMAN

MAILED

MAY 26 2005

U.S. PATENT AND TRADEMARK OFFICE  
BOARD OF PATENT APPEALS  
AND INTERFERENCES

Appeal No. 2005-0950  
Application 09/634,087

ON BRIEF

Before OWENS, KRATZ, and PAWLIKOWSKI, Administrative Patent Judges.

PAWLIKOWSKI, Administrative Patent Judge.

DECISION ON APPEAL

This is an appeal under 35 U.S.C. § 134 from the examiner's final rejection of claims 1, 3, 8-17, and 21-23.<sup>1</sup> Appellants

<sup>1</sup> On page 2 of the answer, the examiner indicates that claims 7, 43 and 44 remain rejected. Also, on page 3 of the answer, the examiner states that claim 21 remains rejected, and that this claim stands or falls with claim 1. However, appellants have decided not to appeal the rejections of claims 7, 21, 43, and 44. Brief, page 3. We refer to the final Office Action of paper no. 16, mailed November 17, 2003, on page 2, wherein claims 7, 43, and 44 are rejected under 35 U.S.C. § 112, second paragraph. Hence, appellants do not appeal this rejection. We note that a withdrawal of an appeal as to some of the claims on appeal operates as an authorization to cancel such claims from the application, and the appeal continues as to the remaining claims. MPEP §1215.03 (August 2001). Hence, upon return of this application to the jurisdiction of the examiner, cancellation of these claims is required. As such, we need not consider claims 7, 21, 43, and 44 in this appeal. Therefore, the appeal as to the rejection under 35 U.S.C. § 112, second paragraph, of claims 7, 43, and 44 is dismissed, and the appeal of the rejection of claim 21 is dismissed.

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have decided not to appeal the rejections of claims 7, 21, 43, and 44. Brief, page 3. Claims 4, 5, 18-20, 24-39, 41, and 42 have been withdrawn from consideration as non-elected claims. Claims 2, 6, and 40 have been cancelled. Answer, page 2.

Claims 1 and 17 are representative of the subject matter on appeal and are set forth below:

1. An oral care device comprising

a body defining a longitudinal axis having a head shaped for insertion into the oral cavity, and

a rocking element mounted on the head, the rocking element including a central portion and a plurality of protrusions extending radially from the central portion along the longitudinal axis of the body, wherein the protrusions taper from a relatively wide base to a relatively narrow tip and wherein the tips are shaped to penetrate the interproximal and subgingival regions of the oral cavity.

17. The oral care device of claim 1 wherein the central portion further includes an opening therethrough sized to allow the rocking element to conform to a tooth's shape during use.

The examiner relies on the following references as evidence of unpatentability:

Thomas, et al. (Thomas)	2,246,867	Jun. 24, 1941
Birch	3,230,562	Jan. 25, 1966
Mark	4,403,623	Sep. 13, 1983
Pai, et al. (Pai)	GB 2 214 420	Sep. 06, 1989

Claims 7, 43, and 44 stand rejected under 35 U.S.C. § 112, second paragraph. However, see our footnote 1 on page 1 of this decision regarding the status of this rejection.

Claims 1, 3, 17, and 22 stand rejected under 35 U.S.C. § 102(b) as being anticipated by Thomas.

Claims 1, 3, 8-16, 22, and 23 stand rejected under 35 U.S.C. § 103 as being unpatentable over Mark in view of Birch.

Claim 21 stands rejected under 35 U.S.C. § 103 as being unpatentable over Mark in view of Birch and further in view of Pai. However, see our footnote 1 regarding the status of this rejection.

On page 2 of the brief, appellants discuss the grouping of the claims. To the extent that any one claim is specifically argued regarding patentability, we consider such claim in this appeal. With regard to claims 8-14, we note that appellants' arguments simply repeat the recitations in these claims, and do not include specific arguments as to why these claims are unobvious over the prior art. Hence, we consider claims 1 and 17 in this appeal. See In re Nielson, 816 F.2d 1567, 1572, 2 USPQ2d 1525, 1528 (Fed. Cir. 1987) and In re Wood, 582 F.2d 638, 642, 199 USPQ 137, 140 (CCPA 1978). See also 37 CFR § 1.192(c)(7)(2003); and 37 CFR § 41.37(c)(1)(vii) (effective September 13, 2004; 69 Fed. Reg. 49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September 7, 2004)).

#### OPINION

I. The rejection of claims 7, 43, and 44 stand rejected under 35 U.S.C. § 112, second paragraph

As discussed above, appellants have not appealed the rejection of claims 7, 43, and 44. This rejection is dismissed.

II. The anticipation rejection of claims 1, 3, 17, and 22 as being anticipated by Thomas

We consider claims 1 and 17 in this rejection.

The examiner's position for this rejection is set forth on page 4 of the answer.

On page 3 of the brief, appellants argue that claim 1 requires that the tips are shaped "to penetrate the interproximal and subgingival regions of the oral cavity". Appellants argue that this phrase, when read in the context of the specification and the figures, conveys a structure, including protrusions, that are long enough, thin enough, rigid enough, and positioned to enter the interproximal regions of the users teeth. Appellants argue that in contrast, the oral care device disclosed in Thomas does not include a feature that would penetrate the interproximal regions of the user's teeth. Appellants argue that the rocking member 16 of Thomas would engage the teeth with rubbing contact and apply helpful massage to the gums. Appellants argue that therefore Thomas fails to teach each element recited in claim 1.

On page 8 of the answer, the examiner rebuts, and states that protrusions 17 of Thomas are located in a position on the head 14 such that these protrusions would be brought into contact with the interproximal and subgingival regions and would penetrate these regions to the extent required by claim 1.

Hence, it is disputed whether Thomas discloses an oral care device including a feature that would penetrate the interproximal regions of a user's teeth. We note that appellants do not dispute that protrusions 17 would penetrate the subgingival regions as appellants admit that the rocking member featured in Thomas would apply helpful massage to the gums. Brief, pages 3-4.

Hence, the issue is whether rocking member 16, having small transversely disposed ribs or corrugations 17, would penetrate

the interproximal region of the user's teeth. This region is defined in appellants' specification as the area between the teeth of a mammal. See page 1, lines 12-13 of appellants' specification. Therefore, the question is whether the rocking member 16, having disposed ribs or corrugations 17, is able to penetrate between the teeth of the user.

We find that Thomas discloses that the rocking member 16, composed of a soft, flexible and preferably, elastic material such as rubber, having an active face which is corrugated so that when the brush is utilized for cleaning teeth, the rocking member 16 will, during a part of the backward and forward movement of the brush, engage the surfaces of the teeth with rubbing contact, thereby tending to more effectively polish the teeth, and which rocking member 16 is also effective in engaging the gums adjacent the teeth, with gentle pressure, so as to apply helpful massage to the gums. See page 1, column 1, lines 13-26 of Thomas. On page 1, in column 2, at lines 44-53, Thomas discloses that the corrugated periphery 17 of member 16 has both rocking contact and rubbing contact with the teeth and the rubbing contact of member 16 with the teeth tends to polish the same. Figure 5 is a perspective view of the rocking element.

Based upon the above discussed teachings of Thomas, because rocking member 16 engages the surface of the teeth, ribs 17 would likewise reach the surface of the teeth. Appellants claim 1 does not indicate the extent of penetration between teeth made by the tips. As ribs 17 engage the surface of one tooth, and then pass to the next tooth, to some degree, ribs 17 would penetrate between those teeth.

With regard to claim 17, on page 4 of the brief, appellants argue that this claim requires that the central portion include an opening to allow the rocking element to conform to a tooth's shape during use.

Beginning on page 8 of the answer, the examiner rebuts and states that rocking member 16 of Thomas includes an opening therethrough which receives pin 18. The examiner states that claim 17 does not preclude the opening from being the one identified as such in Thomas. However, the examiner does not explain how the opening in rocking member 16 allows for the rocking member to conform to a tooth's shape during use. Hence, we agree with appellants that Thomas does not anticipate claim 17.

In view of the above, we therefore affirm the anticipation rejection of claims 1, 3, and 22 as being anticipated by Thomas. However, we reverse this rejection with respect to claim 17.

III. The 35 § 103 rejection, claims 1, 3, 8-16, 22, and 23 as being unpatentable over Mark in view of Birch

We consider claim 1 in this rejection.

The examiner's position in this rejection is set forth on pages 5-7 of the answer. We incorporate the examiner's position as our own.

Beginning on page 5 of the brief, appellants argue that the examiner has not pointed out where, in either Mark or Birch, there is a teaching or suggestion that would have motivated one skilled in the art to combine the teachings as suggested by the examiner to arrive at appellants' invention. Appellants argue that the examiner has improperly used hindsight.

On page 9 of the answer, the examiner rebuts and explains that Mark teaches two positions of a brush head. The first position of the head is a position wherein the head is aligned with the longitudinal axis of the body 12, which is shown in figure 1. The second position is transverse to the longitudinal axis of the body 12, and is shown in figure 2. It is the

examiner's position that substitution of the type of head found in Birch for the head of Mark would result (when in the position shown in figure 2 of Mark) in a rocking element including a central portion and a plurality of protrusions extending from the central portion "along the longitudinal portion of the body". We agree. Contrary to appellants' position that there is no motivation to combine the references, Mark provides sufficient motivation to utilize a head as positioned in figure 2 because this position improves gum massage. See column 1, lines 5-40. We note that obviousness can be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggesting, or motivation to do so found either in the reference or in the knowledge generally available to one of ordinary skill in the art. In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Here, Mark provides sufficient motivation.

In view of the above, we therefore affirm the rejection claims 1, 3, 8-16, 22 and 23 under 35 U.S.C. § 103 as being obvious over Mark in view of Birch.

IV. The 35 § 103 rejection of claim 21 as being obvious over Mark, Birch, and further in view of Pai

As indicated in footnote 1, appellants do not appeal the rejection of claim 21. This rejection is dismissed.

V. Conclusion

The appeal of the rejection under 35 U.S.C. § 112, second paragraph, of claims 7, 43, and 44 is dismissed, and the appeal of the rejection of claim 21 is dismissed. See our footnote 1.

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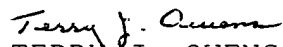
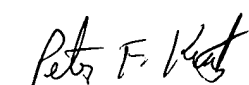
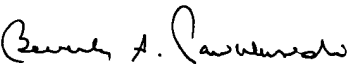
The rejection of claims 1, 3, and 22 under 35 U.S.C.  
§ 102(b) as being anticipated by Thomas is **affirmed**.

The rejection of claim 17 under 35 U.S.C.  
§ 102(b) as being anticipated by Thomas is **reversed**.

The rejection of claims 1, 3, 8-16, 22, and 23 under  
35 U.S.C. § 103 as being unpatentable over Mark in view of Birch  
is **affirmed**.

No time period for taking any subsequent action in  
connection with this appeal may be extended under 37 CFR  
§ 1.136(a)(1)(iv) (effective September 13, 2004; 69 Fed. Reg.  
49960 (August 12, 2004); 1286 Off. Gaz. Pat. Office 21 (September  
7, 2004)).

**AFFIRMED-IN-PART**

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TERRY J. OWENS	)	
Administrative Patent Judge	)	
	)	
PETER F. KRATZ	)	
Administrative Patent Judge	)	
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BEVERLY A. PAWLIKOWSKI	)	
Administrative Patent Judge	)	
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	)	APPEALS AND
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FISH & RICHARDSON, P.C.  
225 FRANKLIN STREET  
BOSTON, MA 02110